

and that has a highlight region for highlighting a given one of the program listings, (b) a video window that contains an unobstructed view of a television program, and (c) a detailed program description of the highlighted program listing;

means for allowing the user to position the highlight region only among the program listings for programs that are currently being broadcast; and

means for automatically updating the detailed program description and the television program video window to correspond to the highlighted program listing whenever the highlight region is positioned on a new program listing.

REMARKS

Claims 1-51 were pending. Claim 37 has been amended. (These Remarks are followed by an Appendix showing how claim 37 has been amended.) The Examiner rejected claims 1-51 under 35 U.S.C. § 103(a) as being unpatentable over LaJoie et al. U.S. Patent No. 5,850,218 (hereinafter "LaJoie") in view of Florin et al. PCT publication No. WO 95/01058 (hereinafter "Florin"). This rejection is respectfully traversed.

Applicants' Amendment

Applicants have amended claim 37. Claim 37 was added in applicants' Reply to Office Action dated February 5, 2001 mistakenly as a duplicate of claim 1. Claim 37 has been amended

to correct this typographical error. Therefore, applicants submit that this amendment is not a "substantial amendment related to patentability" within the meaning of Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000), but instead relates merely to a matter of form.

Applicants' Reply To
The Prior Art Rejection

Claims 1-36

The Examiner rejected claims 1-36 under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Florin. This rejection is respectfully traversed.

As set forth in independent claims 1, 13, and 25, applicants' invention is directed towards an interactive television program guide that simultaneously displays (a) a program list that contains multiple program listings, that only contains program listings of program that are currently being broadcast, and that has a highlight region for highlighting a given one of the program listings, (b) a video window that contains an unobstructed view of a television program, and (c) a detailed program description of the highlighted program listing. The user is allowed to position the highlight region only among the program listings for programs that are currently being broadcast. When the highlight region is positioned on a new program listing, the detailed program description is

automatically updated to correspond to the new program listing while the television program in the video window is unchanged.

This provides a simplified and streamlined program guide display by only displaying programs that are currently being broadcast. By not listing program information for future programs, the user is presented with a program list that is not cluttered (see applicants' specification, page 14, lines 5-22).

LaJoie discloses a cable television system with an interactive program guide. The interactive program guide simultaneously displays (a) a program grid that contains programs that are currently being broadcast and programs that will be broadcast in the future (b) a program cursor for highlighting any one of the programs in the program grid, (c) a program viewing window, and (d) a highlighted program summary which includes a brief description (see column 23, line 44 to column 24, line 15 of LaJoie). The user can navigate the program cursor and the program summary is updated with information for the program highlighted by the program cursor.

The Examiner asserts that "LaJoie might not clearly show to include 'means for allowing the user to position the highlight region only among the program listings for programs that are currently being broadcast'" (emphasis removed) (page 3 of the 4/10/01 Office Action). Applicants submit that a reference either shows or suggests a teaching or it fails to show or suggest a teaching. There is no such thing as a reference

that "might not clearly show" a teaching as the Examiner states on page 3 of the 4/10/01 Office Action. As discussed above and as illustrated in FIG. 16, LaJoie discloses a program grid that includes programs that are currently being broadcast and programs that will be broadcast in the future. In addition, the user can navigate the program cursor among all of the displayed program listings. Therefore, LaJoie fails to disclose or suggest (a) displaying a program list that only contains program listings of programs that are currently being broadcast and (b) allowing a user to position a highlight region only among program listings for programs that are currently being broadcast as specified in claims 1, 13, and 25.

Florin discloses an audio-visual interface for viewing and interacting with programs and services. The list function of Florin allows the user to view current and future TV listings up to one week in advance (see page 34, lines 18-20 of Florin).

The Examiner asserts that Florin teaches that a user can position a highlight region only among the programs listings for programs that are currently being broadcast at the current time. This is not so.

Not All Of The Limitations Of The
Claims Are Shown Or Suggested

As described above, the list function of Florin allows a user to view future TV listings. As shown in FIG. 14 of Florin, the user is highlighting the listing "Party Time" which

is not currently being broadcast. The TV listings in the list function are shown for a one-hour time period and the user can navigate the highlight region to programs up to a week in the future. Therefore, Florin fails to disclose or suggest (a) displaying a program list that only contains program listings of programs that are currently being broadcast and (b) allowing a user to position a highlight region only among program listings for programs that are currently being broadcast as specified in claims 1, 13, and 25.

Furthermore, because Florin states in the preferred embodiment that the list button permits the user to view current and future TV listings, Florin teaches away from (a) displaying a program list that only contains program listings of programs that are currently being broadcast and (b) allowing a user to position a highlight region only among program listings for programs that are currently being broadcast (see page 34 lines 18-20 of Florin).

Applicants respectfully submit that, whether taken alone or in combination, LaJoie and Florin fail to disclose or suggest (a) displaying a program list that only contains program listings of programs that are currently being broadcast and (b) allowing a user to position a highlight region only among program listings for programs that are currently being broadcast as specified in claims 1, 13, and 25. Therefore, on this basis alone, independent claims 1, 13, and 25 and dependent claims 2-

12, 14-24, and 26-36 are allowable over the combination of LaJoie and Florin. Accordingly, applicants respectfully request that the rejection of claims 1-36 be withdrawn.

The Combination of LaJoie and Florin is Improper

Moreover, even assuming *arguendo* that the combination of LaJoie and Florin would result in the claimed invention, and applicants strongly submit that it would not, the Examiner's rejections of claims 1-36 still fails because the Examiner has not provided the requisite motivation to combine LaJoie and Florin.

The Examiner stated that LaJoie might not clearly show allowing the user to position a highlight region only among the program listings for programs that are currently being broadcast. The Examiner asserts that Florin teaches the same technique as LaJoie. Applicants submit that if Florin teaches the same technique as LaJoie, there would be no reason to modify LaJoie with Florin's technique. Nevertheless, the Examiner asserts that it would have been obvious to modify LaJoie with Florin's technique "in order to provide user a convenient and additional feature in browsing and selecting a currently broadcasting program" (see page 4 of the 4/10/01 Office Action). However, the modification to LaJoie would limit the functionality of its time mode by limiting the displayed program listings and limiting the program listings to which the user can navigate. This

modification would, for example, prevent a user from viewing brief descriptions and setting reminders for future program and therefore runs contrary to the overall purpose of LaJoie's time mode.

Applicants respectfully submit that, absent applicants' specification and claims as a roadmap, persons skilled in the art would have no reason to selectively apply Florin's technique to LaJoie to achieve applicants' claimed invention. Applicants therefore respectfully submit that the requisite motivation is lacking from the rejection, and that the present rejection is based on impermissible hindsight reconstruction. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references); In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention"); ACS Hosp. Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1994) (the test for obviousness requires that the references, not the Examiner, provide teaching or suggestion supporting the combination of references offered); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990) (reversing the Board's

obviousness rejection as a "classic example of hindsight reconstruction").

Accordingly, because the Examiner has improperly engaged in hindsight reconstruction, and because the absence of a suggestion to combine is dispositive in an obviousness determination, the Examiner's rejection is improper. Therefore, on this basis alone, applicants respectfully request that the rejection of claims 1-36 be withdrawn.

Claims 37-51

The Examiner rejected claims 37-51 under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Florin. This rejection is respectfully traversed.

As set forth in independent claims 37, 42, and 47, applicants' invention is directed towards an interactive television program guide that simultaneously displays (a) a program list that contains multiple program listings, that only contains program listings of program that are currently being broadcast, and that has a highlight region for highlighting a given one of the program listings, (b) a video window that contains an unobstructed view of a television program, and (c) a detailed program description of the highlighted program listing. The user is allowed to position the highlight region only among the program listings for programs that are currently being broadcast. When the highlight region is positioned on a new

program listing, the detailed program description and the television program in the video window are automatically updated to correspond to the new program listing.

Neither LaJoie nor Florin discloses or suggests the features of independent claims 37, 42, and 47 and dependent claims 38-41, 43-46, and 48-51. More particularly, as described above, LaJoie and Florin fail to show or suggest (a) displaying a program list that only contains program listings of programs that are currently being broadcast and (b) allowing a user to position a highlight region only among program listings for programs that are currently being broadcast as specified in claims 37, 42, and 47.

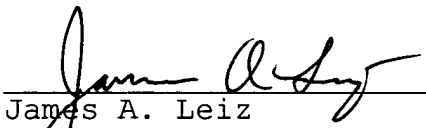
Furthermore, LaJoie and Florin fail to show or suggest automatically updating a detailed program description and the television program in a video window to correspond to a highlighted program listing whenever the highlight region is positioned on a new program listing as defined in claims 37-51.

Accordingly, for at least these reasons, independent claims independent claims 37, 42, and 47 and dependent claims 38-41, 43-46, and 48-51 are allowable. Therefore, applicants respectfully request that the rejection of claims 37-51 be withdrawn.

Conclusion

In view of the foregoing, claims 1-51 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



James A. Leiz
Registration No. 46,109
Agent for Applicant(s)
FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1104
Tel.: (212) 596-9000

APPENDIX

(Showing How Claim 37
has Been Amended)

37. (amended) An interactive television program guide system implemented on user television equipment, comprising:

means for simultaneously displaying (a) a program list that contains multiple program listings, that only contains program listings for programs that are currently being broadcast, and that has a highlight region for highlighting a given one of the program listings, (b) a video window that contains an unobstructed view of a television program, and (c) a detailed program description of the highlighted program listing;

means for allowing the user to position the highlight region only among the program listings for programs that are currently being broadcast; and

means for automatically updating the detailed program description and the television program video window to correspond to the highlighted program listing whenever the highlight region is positioned on a new program listing [while leaving the television program in the video window unchanged].